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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,214	06/12/2001	Jeffrey H. Diamond	0136.0004C	4957

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EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/878,214

Applicant(s)

DIAMOND, JEFFREY H.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,7-19,23-28,34-36,40,41 and 43 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,20-22,29-33,37-39 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following office action is in response to the amendment filed on 2/20/03.

Drawings

In view of the amendment to figure 6, the drawing objection made in the previous office action is hereby withdrawn.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means," "**comprises**," and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the applicant has used the term "comprises". This term should be changed to a term such as "having" or "including".

Claim Rejections - 35 USC § 103

1. Claims 1, 4-6 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,544,587) in view of Pierre (4,423,574).

In regard to claim 1, Nesbitt discloses a structure capable of temporarily protecting a glass pane of a window structure comprising a layer of solidified compressible material capable of providing protection for the glass pane. Nesbitt discloses that said material is flexible and pliable, column 3, line 25 and lines 54-59. Therefore, the panel is compressible because in order to bend and be pliable, the panel must compress at least in some areas. Nesbitt does not

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specifically disclose the use of a shaping member for removable securing on the window structure to define a cavity over the glass pane. Pierre teaches the use of a shaping member 34, figure 6, used in combination with a insulation means to protect an opening in a wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Pierre's shaping member 34 into Nesbitt's invention, because, as taught by Pierre, the member 34 will "provide structural integrity to the panel", column 4, line 42.

In regard to claims 4-6, Nesbitt in view of Pierre disclose the basic claimed invention, further including a securing element for removably securing said compressible structure on said window structure. Said securing element includes a releasable adhesive carried by said shaping member, column 3, lines 50-51, or one or more mechanical securing devices, i.e. suction cups, figures 6 and 7, wherein one or more of said securing devices is interposed between a perimeter and said window structure.

In regard to claims 20 and 21, Nesbitt in view of Pierre disclose the basic claimed invention, wherein said layer of solidified compressible material has a thickness in the range of 0.5 inch to 12.0 inches and 1.0 inch to 4.0 inches. Nesbitt discloses that the sheet is from $\frac{1}{4}$ inch to $1\frac{1}{2}$ inches, column 3, lines 66-67. Therefore, Nesbitt's sheet is within the ranges specified by the applicant.

In regard to claim 22, Nesbitt in view of Pierre disclose the basic claimed invention, wherein said member is adjustable in external size in response to a variation in the amount of material in said cavity. Nesbitt discloses that the thickness of the member may be varied. Therefore, one could adjust the thickness of the member to any desired amount by merely using more or less layers of material.

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2. Claims 29-33, 37-39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,544,587).

In regard to claim 29, Nesbitt discloses a temporarily protected window structure comprising a window structure having a glass pane 30 mounted in a frame 31, and a compressible structure removably secured on said window structure and including a panel of solidified compressible foam material disposed over the glass pane to protect said glass pane from damage due to storms. Nesbitt discloses that said panel is sufficiently flexible or pliable, column 3, line 25 and lines 54-59. Therefore, the panel is compressible because in order to bend and be pliable, the panel must compress at least in some areas. In regard to the foam material, although Nesbitt does not specifically refer to his material as foam, he does state that the material comprises air bubbles, column 4, lines 23-26. Therefore, it is known in the art that foam materials contain such air bubbles. In regard to the placement of the panel, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the panel on the exterior of the window, because by doing so, it will protect the window from damage. Also, by having the panel on the outside of the window, it will not be in the way of the occupants on the inside of the structure. Finally, it has been held that rearranging parts of an invention involves only routine skill in the art. In the instant case, Nesbitt's panel would work equally well if it were placed on the inside or outside of the window.

In regard to claims 30-33, Nesbitt discloses the basic claimed invention, further including a securing element removably securing said compressible structure on said window structure. Said securing element includes one of adhesive, column 3, lines 50-51, or one or more

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mechanical securing devices, i.e. suction cups, figures 6 and 7, wherein one or more of said securing devices is interposed between a perimeter and said window structure.

In regard to claim 37, Nesbitt discloses a method of temporarily protecting a glass pane of a window structure in a building from damage comprising the steps of releasably securing a pre-formed panel of solidified compressible material over the glass pane, leaving the panel in place for a period of time to protect the glass pane from damage, and removing the panel from the glass pane, figures 6 or 7. Nesbitt does not specifically disclose that the panel is placed on the window before a storm and removed after the storm. He also does not specifically disclose that the panel is placed on the outside of the window. In regard to the placement of the panel and the times in which it is placed on said window, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the panel on the outside of the window before a storm, because during the storm, there will be strong winds. Therefore, by having the panel in place, it will insulate the window as well as protect said window from damage caused by flying debris. It would also be obvious to place the panel on the outside of the window for the reasons set forth above with respect to claim 29. Finally, it would also be obvious to one having ordinary skill in the art to remove the panel after the storm, because one would want to see out of the window. Thus, the panel would have to be removed sometime so that the window could be used.

In regard to claim 38, Nesbitt discloses the basic claimed invention, wherein said step of releasably securing includes adhesively securing the panel to the glass pane, column 3, lines 50 and 51.

In regard to claim 39, Nesbitt discloses the basic claimed invention, wherein said step of releasably securing includes positioning one or more securing devices (i.e. suction cups figures 6 and 7) between the window structure and an external perimeter of the panel.

In regard to claim 42, Nesbitt discloses the basic claimed method, further including, subsequent to said step of removing, the step of storing the panel for reuse. Nesbitt states in column 2, lines 26-27 that the insulator may be stored until ready for use.

Allowable Subject Matter

2. Claims 2, 3, 7-19, 23-28, 34-36, 40, 41, and 43 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:
Said claims are allowable for the reasons set forth in the previous office action.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 4-6, 20-22, 29-33, 37-39, and 42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.
April 4, 2003

A handwritten signature in cursive script, reading "Brian Glesner", followed by a long horizontal flourish.

BRIAN E. GLESSNER
PATENT EXAMINER